

REMARKS

Applicants respectfully request favorable reconsideration and reexamination of this application.

Claim 8 has been revised editorially. Claim 15 has been revised, and is supported by, for example, page 38, lines 1-3 and FIGS. 8-9 in the Specification.

There is no new matter. Claims 1-20 are pending. Claims 15-20 have been withdrawn from consideration.

Priority

Applicants file herewith a verified translation of JP 2003-386016 to perfect the priority claim of the present application.

Election/Restriction

Applicants traverse the restriction requirement. The Examiner maintained the restriction requirement by relying on MPEP 821.03 and stated that the restriction requirement is justified because Applicants have “received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits” (page 3 of the Office Action).

MPEP 821.03 states “if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.” MPEP 821.03 is applicable only to claims presented after an office action. Claims 1-20 were originally presented for prosecution on the merits. Thus, the Examiner improperly relied on MPEP 821.03 in making the restriction requirement and continues to improperly rely on the same in maintaining the restriction.

Further, for claims 1-20, “unity of invention” is applicable, not restriction practice (see MPEP 1893.03(d)). One or a group of inventions may be linked as to form a single general inventive concept, and “unity of invention” requirement is fulfilled when a group of inventions claimed in an application has a technical relationship among those inventions involving one or

more of the same or corresponding technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

37 CFR § 1.141(b) states that “where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made” (emphasis added).

Applicants respectfully submit that the claims 1-14 and 17-18 are directed to a product and claims 15-16 and 19-20 are directed to a process specially adapted for the manufacture of said product. Accordingly, claims 1-20 have unity of invention, and the claims should be considered jointly under 37 CFR § 1.141(b). The Examiner has not provided any reasoning as how the claims 1-20 lack unity of invention.

Further, the Office Action erroneously stated again that claims 15-20 are drawn to a method (page 3 of the Office Action). Claims 17-18 are not drawn to a method. Claims 17-18 are drawn to a product. Therefore the reason provided for the restriction of claims 17-18 is unreasonable. Further, merely because claims 19-20 are directed towards a process and claims 17-18 are directed towards a product does not necessarily make the claims 19-20 distinct from and independent of the invention claimed in claims 17-18. Claims 19-20 are directed towards making the item of claim 17. Thus, claims 17-18 and 19-20 have a technical relationship such that unity of invention is applicable.

Further, merely because claims 15-16 are directed towards a process and claims 1-14 are directed towards a product does not necessarily make the claims 15-16 distinct from and independent of the invention claimed in claims 1-14. Claims 15-16 are directed towards making the item of claim 1. Thus, claims 1-14 and 15-16 have a technical relationship such that unity of invention is applicable.

Further, the product of claim 17 share sufficiently similar features with the product of claim 1. For example, both claims 1 and 17 require a surface layer, a binder layer, high-refractive-index glass beads, a print resin layer, a focusing layer, a metal layer, and a pressure-sensitive adhesive layer. Thus, claims 1 and 17 have a technical relationship such that unity of

invention is applicable. Therefore, Applicants request that restriction requirement be withdrawn and further if claim 1 is allowed, that claims 17-18 be reinstated and also allowed.

The Examiner maintained the restriction stating that Group 2 (claims 15-16) “requires the high-refractive glass beads to be embedded in the binder layer where the print resin layer is formed. Groups 1, 3 and 4 do not” (page 24 of the Office Action).

As presented previously in the Response to the Restriction Requirement submitted on July 1, 2009, Applicants direct the Examiner’s attention once again to claim 15 (Group 2), which clearly recites “embedding the high-refractive-index glass beads in a part of the binder layer where the print resin layer is not formed.” To clarify this feature, claim 15 has been revised to recite “so as to dispose the high-refractive-index glass beads in the binder layer on which the print resin layer is not formed.” Claim 16 depends from claim 15, and shares this feature. Therefore, the reasoning stated by the Examiner does not justify the restriction.

Further, the Examiner maintained the restriction stating that Group 3 (claims 17-18) “requires a print layer having an affinity with a sublimable dye” (page 24 of the Office Action). Applicants respectfully note that Group 4 (claims 19-20) is directed towards a method of making the product of claim 17. Further, claim 19 (Group 4) recites “heat-treating subsequently so as to sublimate the sublimable dye, allow the sublimable dye to penetrate the surface resin layer and form an image in the image formation resin layer for obtaining a print layer.” Claim 8 (Group 1) recites an “image formation resin layer” that corresponds to the print layer of Group 3, “the image formation resin layer having an affinity with the sublimable dye.” Claim 16 (Group 2) recites “an image formation resin layer having an affinity with the sublimable dye” that corresponds to the print layer of Group 3. Therefore, reasoning stated by the Examiner does not justify the restriction.

Further, the Examiner maintained the restriction stating that Group 1 (claims 1-14) “requires a print layer comprising a room temperature curing resin” (page 24 of the Office Action). The Examiner has mischaracterized the claims. Applicants respectfully direct the Examiner’s attention to claim 1 (Group 1) which clearly recites “the print resin layer is made of a composition containing a room temperature curing resin as a main component.” Print layer is a different from print resin layer. Thus, Group 1 requires that the “print resin layer” includes a room temperature curing resin.

Applicants respectfully direct the Examiner's attention to claim 15 (Group 2) which recites "curing the print resin layer at room temperature." Further, Applicants respectfully direct the Examiner's attention to claim 17 (Group 3) which recites "the print resin layer is made of a composition containing a room temperature curing resin as a main component." Group 4 (claims 19-20) is directed to the method of making the item of claim 17 (Group 3), and thus likewise shares these features. Therefore, this does not justify the restriction.

Further, the Examiner maintained the restriction stating that Group 4 (claims 19-20) "requires a transfer paper" and "Group 1 does not" (page 24 of the Office Action). However, Group 1 is directed to a product and Group 4 is directed to a method. The transfer paper is part of an intermediate stage of production, and thus it is understandable that it would not be found in the product. In fact, the transfer paper is indicated as being removed during the method of claim 19.

Therefore, no adequate basis has been established for the restriction requirement and/or no adequate basis exists due to the claim revisions. Applicants request that the restriction requirement be withdrawn.

Claim Objections

Claim 5 was not revised in the Amendment filed on July 26, 2010. The apparent misspelling of word "comprising," that seems to be showing as "comprising" in the electronic version of the Amendment is believed to have been caused by electronic scanning and transferring of the electronic file for the use of the EFS Web. Applicants submit that claim 5 is as originally filed. Claim 5 recites "the retroreflective sheet for security according to claim 1, further comprising a self-destructive layer, wherein the pressure-sensitive adhesive layer is disposed between the metal layer and the self-destructive layer." Applicants respectfully request withdrawal of the objection.

Claim Rejections - 35 USC § 103

Claims 1-4, 6, 7, and 14 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al. (US 5866236) in view of Ochi et al. (US 5912316) and further in view of Araki et al. (US 5714223) and further in view of Kuo et al. (US 2006/0029753). Applicants respectfully traverse this rejection. A verified translation of priority document (JP 2003-386016) for the

present application, which antedates Kuo et al., is submitted herewith. Applicants respectfully request that the translation of the priority document be made of record and further request that this rejection be withdrawn.

Claim 5 was rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., Araki et al., and Kuo et al. in view of Rivera et al. (US 2005/0179253). Applicants respectfully traverse the rejection. Kuo et al. is not available as a prior art. Rivera et al. does not remedy the deficiencies of Faykish et al., Ochi et al., and Araki et al. stated above in regard to claim 1. Claim 5 is patentable for at least the same reasons as claim 1 from which it depends. Applicants respectfully request that this rejection be withdrawn.

Claims 8-9 and 13 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., Araki et al., and Kuo et al. in view of Pearce et al. (US 5342821). Applicants respectfully traverse the rejection. Kuo et al. is not available as a prior art. Pearce et al. does not remedy the deficiencies of Faykish et al., Ochi et al., and Araki et al. stated above in regard to claim 1. Claims 8-9 and 13 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

Claims 10-12 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., Araki et al., Kuo et al., and Pearce et al. in view of Bourdelais et al. (US 5342821). Applicants respectfully traverse the rejection. Kuo et al. is not available as a prior art. Bourdelais et al. does not remedy the deficiencies of Faykish et al., Ochi et al., Araki et al., and Pearce et al. stated above in regard to claims 1 and 8. Claims 10-12 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

Claims 8-13 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., Araki et al., and Kuo et al. in view of Yukawa et al. (US 2005/0148469). Applicants respectfully traverse the rejection. Kuo et al. is not available as a prior art. Yukawa et al. does not remedy the deficiencies of Faykish et al., Ochi et al., and Araki et al. stated above

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in regard to claim 1. Claims 8-13 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned attorney-of record, Douglas P. Mueller (Reg. No. 30,300), at (612) 455-3804.

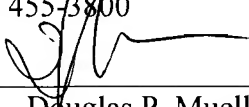


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Respectfully submitted,

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